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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/483,537 01/14/00 WILSON

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008698
STANDLEY & GILCREST LLP
495 METRO PLACE SOUTH
SUITE 210
DUBLIN OH 43017

TM02/0402

EXAMINER

BERGIN, J

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

04/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/483,537

Applicant(s)

WILSON, ROBERT D.

Examiner

James S. Bergin

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Species A; figure 2
Species B; figure 3
Species C; figure 4
Species D; figure 5.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic to all species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-6 and 17-20** are rejected under 35 U.S.C. 102(b) as being anticipated by Kemp, "Discover Debuts Its First Platinum Card", DM News.

Kemp discloses a system for distributing payment vehicles comprising: payment rights such as a rebate for an owner of a Discover card entitled to receive a refund from the Discover card company ; a sponsor of spending vehicles, such as gift certificates, being the Discover card company, said gift certificates redeemable at one of Discover's Platinum Partners; an assignment of payment rights, such as the rebate entitlement, by the owner of the credit card back to the Discover card company in return for which the Discover card company issues spending vehicles back to the card owner in an amount related to the assigned payment rights.

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Regarding **claims 3 and 4**, Discover Card company, the sponsor of the spending vehicles is a financial institution.

Regarding **claim 5**, Discover card company transfers a payment to the relevant one of the Discover Platinum Partners in accordance with the assignment of the rebate entitlement.

Regarding **claim 6**, Kemp discloses that the value of the gift certificates issued by Discover card exceeds the value of the assignment of the rebate entitlement.

Regarding **claim 17**, Kemp discloses that that the Discover card company issues a plurality of gift certificates (spending vehicles) from any of Discover's Platinum Partners nationwide merchants (a plurality of sponsors) from varied product categories, said gift certificates being issued by Discover on behalf of the merchants in accordance with the assignment of the rebate entitlement.

4. **Claims 7-16** are rejected under 35 U.S.C. 102(b) as being anticipated by Kemp, "Discover Debuts Its First Platinum Card", DM News.

Kemp inherently discloses a method of performing the system for distributing payment vehicles outlined above.

Regarding **claim 13**, Kemp discloses that the Discover card company issues a plurality of gift certificates redeemable at any one of Discover's Platinum Partners nationwide merchants from varied product categories.

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Conclusion

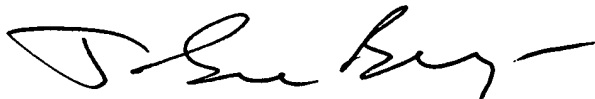
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hardesty (6,105, 865), Ferguson et al. (5,991,736), Fernandez-Holmann (5,787,404), Burton et al. (5,025,372), Simpson (6,070,153), Grant et al. (5,878,405), Fraser (WO 98/28699), Credit Card News article, "Discover's Platinum May Stand Out in the Platinum Crowd", U.S. News & World Report article "It's payback time" are cited to provide relevant systems for distributing spending vehicles issued from a sponsor to an individual in an amount related to an assigned payment right. "YOUR PLATINUM PARTNER CERTIFICATE HAS ARRIVED", has been cited to show Platinum's rebate certificate redeemable for Omaha Steaks and to show a listing of the Platinum Partners, including the financial services company Morgan Stanley Dean Witter Online.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 703 308-8549. The examiner can normally be reached on Monday-Thursday 8.30-6.00 and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millen can be reached on 703 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-1396 for regular communications and 703 308-1396 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.



James S. Bergin

Examiner
March 25, 2001



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100